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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,001	11/10/2005	Francois Berthiaume	00786/434002	2396
21559	7590	09/18/2008		
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			EXAMINER SCHUBERG, LAURA J	
			ART UNIT 1657	PAPER NUMBER
			NOTIFICATION DATE 09/18/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentadministrator@clarkelbing.com

Office Action Summary

Application No.

10/531,001

Applicant(s)

BERTHIAUME ET AL.

Examiner

LAURA SCHUBERG

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17, 21-30, 36-38, 43 and 63 is/are pending in the application.
- 4a) Of the above claim(s) 1-14, 17, 21-30, 36-38 and 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/18/06 6/10/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group II (claim 43) in the reply filed on 05/23/2008 is acknowledged.

Claims 1-14, 17, 21-30, 36-38, 43 and 63

Claims 1-14, 17, 21-30, 36-38, and 63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim 43 has been examined on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 43 is rejected under 35 U.S.C. 102(b) as being anticipated by Kay et al (US 6,107,028).

Claim 43 is drawn to a solution for reducing intracellular lipid storage material of a donor cell, tissue, or organ comprising a catabolic hormone selected from a group and an amino acid selected from a group.

Kay et al describe a media solution that contains hepatocyte growth factor (a catabolic hormone from the claimed group) and glutamine (an amino acid from the claimed group) (column 19 lines 40-46). While the limitation of “for reducing intracellular lipid storage of a donor cell, tissue or organ” is not described, this limitation is with regard to the intended use of the claimed invention and is only given patentable weight in so far as it affects the physical structure of the claimed solution. Since the reference solution is in a physical format (liquid) suitable for the claimed intended use, the limitation regarding intended use is deemed to be met by the reference solution.

Therefore the teaching of Kay et al anticipates Applicant's invention as claimed.

Claim 43 is rejected under 35 U.S.C. 102(b) as being anticipated by Washizu et al (Tissue Engineering, 2000, from IDS 12/18/2006).

Washizu et al describe a standard culture medium that includes glucagon (a catabolic hormone from the claimed group) and glutamine (an amino acid from the claimed group) (page 499-table 1). While the limitation of “for reducing intracellular lipid storage of a donor cell, tissue or organ” is not described, this limitation is with regard to the intended use of the claimed invention and is only given patentable weight in so far as it affects the physical structure of the claimed solution. Since the reference solution is

in a physical format (liquid) suitable for the claimed intended use, the limitation regarding intended use is deemed to be met by the reference solution.

Therefore the teaching of Washizu et al anticipates Applicant's invention as claimed.

Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Snodgrass et al (US 6,355,237).

Snodgrass et al describe a media solution that contains leptin (a catabolic hormone from the claimed group) and glutamine (an amino acid from the claimed group) (column 14 lines 31-37). While the limitation of "for reducing intracellular lipid storage of a donor cell, tissue or organ" is not described, this limitation is with regard to the intended use of the claimed invention and is only given patentable weight in so far as it affects the physical structure of the claimed solution. Since the reference solution is in a physical format (liquid) suitable for the claimed intended use, the limitation regarding intended use is deemed to be met by the reference solution.

Therefore the teaching of Snodgrass et al anticipates Applicant's invention as claimed.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA SCHUBERG whose telephone number is (571)272-3347. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leon B Lankford/
Primary Examiner, Art Unit 1651

Laura Schuberg

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